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| 09/849,735 | 05/04/2001 | John A. Blackman | 103291-42913 | 8085 |
| 26345 | 7590 | 04/19/2004 | EXAMINER | |
| GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497 | | | FRANCIS, FAYE | |
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3712

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,735

Applicant(s)

BLACKMAN ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 20-24 and 26-34 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 13-19 have been cancelled in paper number 5.
2. With respect to claims 33 and 34: for the purpose of this Office Action, note that claims 10-11 are treated as if they are dependent on claim 32 so as to give effect to the specific limitations therein.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rocker in claim 31, the sliding arm in claim 32 and the aperture in the tab in claim 33 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the requirement in claims 1,20 and 22-23 that "said interior surface comprised of a like material throughout". Additionally, proper antecedent basis should be provided in the specification for the terms "a rocker", "a sliding arm" and "the tab having an aperture" in, claims 31-34.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 20 and 22-23 are finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the recitation in the claims of " the interior surface comprised of a like material throughout " as now recited in claims 1, 20 and 22-23.

7. Claims 31-34 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 31, it is not clear how the rocker arm has a bias toward contacting the contact?

With respect to claim 32, it is not clear how the switch includes a sliding arm?

With respect to claim 33, it is not clear how the aperture mates with a portion of the sliding arm?

With respect to claim 34, it is not clear how the tab is configured to move the sliding arm?

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 8, 20-22 and 29-30 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Chabert.

Chabert discloses in Figs 1-6, an inflatable object [balloon 1], a shell [envelope 2], a circuit coupled to the interior portion [Fig 5] and a switch 25, which is configured to automatically change from the open circuit position to the closed circuit position as the inflatable apparatus is inflated [col 1 lines 19-27].

The requirement in claims 1 and 21 for a tab is met by either end part 21 or actuation contact 26 wherein the proximal portion of the tab is in contact with the switch and the distal portion of the tab is coupled to the inflatable device as recited in claim 1 and the distal portion of the tab is coupled to interior surface as recited in claim 8.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 2 and 3 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Official Notice hereby taken that it is well known to utilize batteries to power toys.

Chabert discloses most of the elements of these claims as stated above but for a plurality of batteries.

In view of the Official Notice taken above that it is well known to utilize batteries to power toys, it would have been obvious to provide the device of Chabert with batteries in order to generate additional power.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Margolis.

Chabert discloses most of the elements of these claims as stated above but for a Mylar balloon.

Margolis teaches the concept of making balloons out of Mylar material. It would have been obvious to make the balloon in the device of Chabert out of Mylar material as suggested in Margolis reference in order to increase durability.

13. Claim 7 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Official Notice hereby taken that piezoelectric sound generators are conventional.

Chabert discloses most of the elements of these claims as stated above but for a piezoelectric sound generator.

In view of the Official Notice above that piezoelectric sound generators are conventional, it would have been obvious to provide the device of Chabert with the

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piezoelectric sound generator in order to obtain a durable, inexpensive, light weight and high volume sounding device making the device more fun to play with.

14. Claims 23-24 and 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Margolis and in view of Official Notice hereby taken that it is well known to utilize batteries to power toys and in view of Official Notice hereby taken that piezoelectric sound generators are conventional.

Chabert discloses most of the elements of these claims as applied to claims 1, 8 and 20-22 above including a valve 31 as recited in claim 26.

Chabert does not disclose a plurality of sheets, a sound producing circuit comprising a plurality of batteries, a piezoelectric sound generator and a Mylar balloon.

Margolis teaches the concept of providing Mylar balloon having a plurality of sheets and a sound producing circuit. It would have been obvious to make the balloon in the device of Chabert out of Mylar material having a plurality of sheets as suggested in Margolis reference in order to increase durability.

In view of the Official Notice taken above that it is well known to utilize batteries to power toys, it would have been obvious to further provide the modified device of Chabert with batteries in order to generate additional power.

In view of the Official Notice above that piezoelectric sound generators are conventional, it would have been obvious to further provide the modified device of Chabert with the piezoelectric sound generator in order to obtain a durable, inexpensive, light weight and high volume sounding device making the device more fun to play with.

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Allowable Subject Matter

15. Claims 5-6 and 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 27-28 and 31-34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first or second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

17. Applicant's arguments filed 12/31/03 have been fully considered but they are not persuasive.

It is noted that the applicant appears to indicate that claims 1-8 and 13-34 are pending in the application, however the examiner would like to point out that the only claims pending in the application are claims 1-12 and 20-34.

The office action mailed on 12/20/02 inadvertently stated that the restriction mailed on 10/28/02 was withdrawn [the restriction was mailed on 10/1/02]. However, the restriction was not withdrawn and the examiner only examined claims 1-12 and 20-28 [see paper number 5].

In response to applicant's argument on page 11 second paragraph that the examiner failed to address the traversal. The examiner would like to point out that first the restriction was not made provisionally and secondly, although the applicant election was with traverse, the applicant also specifically cancelled the non-elected claims 13-19. Since the applicant had canceled claims 13-19, there was no reason for the

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examiner to address the traversal. Additionally, the examiner would like to point out that per the Rules once a claim has been cancelled the applicant couldn't reinstate the same claims.

In response to applicant's argument on page 14 that Chabert does not disclose, teach, or suggest a circuit coupled to the interior surface because the power source in Chabert's balloon is located outside the balloon. The examiner would like to point out that the claims do not require the power source to be inside the balloon. All that is required is that the power source be some how connected to the interior surface which is clearly shown by the Chabert reference as stated above, Surely the applicant is not suggesting that he is the first to provide a power source inside an inflatable device [see for example US 5,725,445 and US 5,609,411 that clearly disclose a battery inside an inflatable device].

In response to applicant's argument on page 15 regarding Official Notice, please note the cited references US 5,254,007 to Eagan and US 5,893,798 to Stambolic et al that teach desirability of using piezoelectric buzzer means as a speaker element to output sound from a sound/voice chip in a portable sound generating device.

Applicant's arguments with respect to the rejections of claims 20, 23, 24, 27, 28 and 30 have been considered but are moot since rejections no longer relied on.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF



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